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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Erik Nilsson

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EXAMINER

SMALLEY, JAMES N

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,377	Applicant(s) NILSSON, ERIK	
	Examiner JAMES N. SMALLEY	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 24, 2010 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 4, 6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1, from which the remaining claims depend, limits the dispensing opening being located above the fully-filled liquid level. However, at best, the opening appears to be parallel with the fully filled liquid level, since both are located in the plane of top wall.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 3, 4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vlasaty et al. US 5,106,015 in view of Fujimoto US 5,551,629 and in view of Case US 1,685,147.

Examiner notes claim 1 properly invokes 35 U.S.C. 112, 6th paragraph for "means-plus-function" regarding the "mutually co-acting fastening means" and asserts the connection taught between the tube and the closure of Case '147 performs the same sealing/dispensing function in substantially the same manner.

Vlasaty '015 teaches a parallelepiped package comprising a square container, an opening including a tube (24a), and a closure element (27) disposed on a triangular surface (21). Regarding use of the container as a "beverage packaging unit," Examiner notes no structural features are being read into the term. The container of Vlasaty '015, while being disclosed for use with granular substances, is capable of being used in the intended manner as a beverage container. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

The reference, as applied, teaches all limitations substantially as claimed, but fails to teach the closure element being a generally pyramidal body, and also fails to teach the closure element having a cavity extending therethrough, which is rotated into alignment with an opening in the tubular part.

Fujimoto '629 teaches, in the embodiment of figure 8, a pyramid shaped closure for the opening of a rectangular container. One of ordinary skill in the art would recognize the closure is shaped to complete the rectangle at the corner.

Case '147 teaches it is known to form a closure cap, which is snap-connected to the tube, with a cavity extending therethrough, which is axially rotated into alignment with an opening in the tubular part, in order to dispense the container products.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the container closure of Vlasaty '015, forming it with a cavity extending therethrough, and

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forming the tubular part/spout with an opening, such that the cavity and the opening can be rotationally aligned for dispensing, or misaligned for sealing, as taught by Case '147, motivated by the benefit of allowing a user to dispense the container contents, and reseal the container, with fewer rotations.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the closure cap of Vlasaty '015, forming it in the shape of a pyramid, as taught by Fujimoto '629, motivated by the benefit of completing the entire shape of the square/rectangular shaped container, motivated by the benefit of presenting the completed whole shape as an aesthetic to the consumer. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

The Supreme Court in *KSR* reaffirmed the familiar framework for determining obviousness as set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), but stated that the Federal Circuit had erred by applying the teaching- suggestion-motivation (TSM) test in an overly rigid and formalistic way. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1391. Specifically, the Supreme Court stated that the Federal Circuit had erred in four ways: (1) "by holding that courts and patent examiners should look only to the problem the patentee was trying to solve " (*Id.* at ___, 82 USPQ2d at 1397); (2) by assuming "that a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem" (*Id.*); (3) by concluding "that a patent claim cannot be proved obvious merely by showing that the combination of elements was obvious to try" (*Id.*); and (4) by overemphasizing "the risk of courts and patent examiners falling prey to hindsight bias" and as a result applying "[r]igid preventative rules that deny factfinders recourse to common sense" (*Id.*). In *KSR*, the Supreme Court particularly emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at ___, 82 USPQ2d at 1395.

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Furthermore, the Supreme Court issued rationales which support the conclusion of obviousness, and which can be found in the MPEP 2141(III). Under rationale (A), it is obvious to combine known elements in a predictable manner. Under rationale (B), it is obvious to substitute a known device for another, with predictable results. Examiner asserts the combinations above are thus found to be obvious in view of the Supreme Court's rationales for finding of obviousness, as the obtained results of rotational dispensing, and forming a closure to complete the whole of a geometric shape, are predictable and lack an unexpected, synergistic result.

Regarding newly amended claim language of August 24, 2010, Examiner asserts the claimed prior art device is capable of used in the intended manner, for example, the term "stands on its bottom wall" does not preclude the device standing on a portion of the bottom wall, i.e. if propped up on an edge thereof.

Regarding claim 2, the connection between the closure and neck of Case '147 is a snap-type connection, as the closure skirt (19) fits into recess (14), which has a lesser diameter than the upper portion of the spout (12), thus inherently requiring resilient distortion.

Regarding claim 4, Case '147 teaches rotating the closure and tube openings out of alignment in order to seal the container, as indicated by the "open" and "shut" arrows being diametric of each other.

Regarding claim 6, Examiner notes the closure of Case '147, figure 2, is in sealing abutment both with the opening of the tubular part (in the closed configuration, which is not shown, but would be given the contact between the bottom surface of the cap, and the top surface of the tubular member shown in the figure), and with the container shoulder, and thus it would be obvious to modify the closure cap of Vlasaty '015 such that the closure both seals the tubular opening, and is in contact with the triangular surface (21).

Regarding claim 7, the combined prior art would not have any projections, as the resultant shape as taught by Fujimoto is a completed parallelepiped.

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Response to Arguments

6. Applicant's arguments filed August 24, 2010 have been fully considered but they are not persuasive.

a) Applicant argues Fujimoto has to be completely removed, and thus cannot be used in an obviousness rejection.

Examiner notes Fujimoto is only used to teach that it is known to shape a closure for a parallelepiped package having a dispensing port located on the corner such that it completes the entire shape.

b) Applicant argues Case cannot be used because it is a collapsible tube.

Case is only used to show it is known to provide a rotatable dispensing closure. One of ordinary skill in the art would not be impeded by the type of container, while applying a benefit for a dispensing port.

c) Applicant argues there is no motivation to combine the references.

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, the references are all drawn to dispensing containers, and one of ordinary skill in the art would have found it obvious to combine the teachings.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and

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does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper.

See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Lastly, the question is not whether the prior art devices can be physically combined, but whether a person of ordinary skill in the art would have found it obvious to combine different features or elements of known devices in a predictable way. See *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983): "There is a distinction between trying to physically combine the two separate apparatus disclosed in two prior art references on the one hand, and on the other hand trying to learn enough from the disclosures of the two references to render obvious the claims in suit. ...Claims may be obvious in view of a combination of references, even if the features of one reference cannot be substituted physically into the structure of the other reference."

d) Applicant argues, regarding new claim 7, that Vlasaty and Case each have respective projections (27) and 912).

Applicant's argument is misleading. The combined prior art would not have any projections, as the resultant shape as taught by Fujimoto is a completed parallelepiped. Moreover, Applicant cites dispensing ports in each reference, particularly (27) of Vlasaty, while ignoring their own equivalent projection (4).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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3781

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Examiner, Art Unit 37813